PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To:
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PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43*bis*.1)

Date of mailing *(day/month/year)*	30 JAN 2009
Applicant's or agent's file reference DUC-006PC 2	**FOR FURTHER ACTION** See paragraph 2 below

International application No.	International filing date *(day/month/year)*	Priority date *(day/month/year)*
PCT/US 07/21648	10 October 2007 (10.10.2007)	12 October 2006 (12.10.2006)

International Patent Classification (IPC) or both national classification and IPC
IPC(8) - H04L 9/00 (2009.01)
USPC - 713/153

Applicant BLACK DUCK SOFTWARE, INC.

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☒ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1*bis*(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/US	Date of completion of this opinion	Authorized officer:
Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450, Alexandria, Virginia 22313-1450 Facsimile No. 571-273-3201	14 January 2009 (14.01.2009)	Lee W. Young PCT Helpdesk: 571-272-4300 PCT OSP: 571-272-7774

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/US 07/21648

Box No. I Basis of this opinion

1. With regard to the **language**, this opinion has been established on the basis of:

   ☒ the international application in the language in which it was filed.

   ☐ a translation of the international application into _____ which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).

2. ☐ This opinion has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43*bis*.1(a))

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, this opinion has been established on the basis of:

   a. type of material

      ☐ a sequence listing

      ☐ table(s) related to the sequence listing

   b. format of material

      ☐ on paper

      ☐ in electronic form

   c. time of filing/furnishing

      ☐ contained in the international application as filed

      ☐ filed together with the international application in electronic form

      ☐ furnished subsequently to this Authority for the purposes of search

4. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

5. Additional comments:

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

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Box No. IV Lack of unity of invention

1. ☒ In response to the invitation (Form PCT/ISA/206) to pay additional fees the applicant has, within the appicable time limit:

   ☐ paid additional fees

   ☐ paid additional fees under protest and, where applicable, the protest fee

   ☐ paid additional fees under protest but the applicable protest fee was not paid

   ☒ not paid additional fees

2. ☐ This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rule 13.1, 13.2 and 13.3 is

   ☐ complied with

   ☒ not complied with for the following reasons:

Reasons for Lack of Unity of Invention:

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In order for all inventions to be searched, the appropriate additional search fees must be paid.

Group I: claims 1-24, drawn to a method/system for export compliance containing performing an examination of one or more content files and identifying content used by or included in the one or more content files that is indicative of content subject to export control..

Group II: claims 25-39, drawn to a method/system for examining a software program to identify an algorithm containing identifying a first portion of the software program that is similar to a portion of a comparison software program and indicating that the software program uses the identified algorithm.

The inventions listed as Groups I - II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of the Group I invention is a method/system for export compliance containing performing an examination of one or more content files and identifying content used by or included in the one or more content files that is indicative of content subject to export control. The special technical feature of the Group II invention is a method/system for examining a software program to identify an algorithm containing identifying a first portion of the software program that is similar to a portion of a comparison software program and indicating that the software program uses the identified algorithm. None of these special technical features are common to the other groups, nor do they correspond to a special technical feature in the other groups. Therefore, unity of invention is lacking.

4. Consequently, this opinion has been established in respect of the following parts of the international application:

   ☐ all parts

   ☒ the parts relating to claims Nos. 1-24

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

International application No.
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Box No. V **Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Claims	13-24	YES
	Claims	1-12	NO
Inventive step (IS)	Claims	None	YES
	Claims	1-24	NO
Industrial applicability (IA)	Claims	1-24	YES
	Claims	None	NO

2. Citations and explanations:

Claims 1-12 lack novelty under PCT Article 33(2) as being anticipated by US 2003/0163684 A1 (Fransdonk).

As per claim 1, Fransdonk discloses a method for export compliance, (see FIG. 1, and para [0010], [0016], [0022]), comprising: performing a computer-assisted examination of one or more content files (see FIG. 1, and para [0023]); in response to the examination results, identifying content used by or included in the one or more content files that is indicative of content subject to export control (see FIG. 1, 7, and para [0013], [0019], [0032], [0105], [0232]); determining, in response to the identified content, export requirements applicable to the one or more content files (see FIG. 1, 7, and para [0105], [0107]); and providing an indication of the determined export requirements (see FIG. 4, 7, and para [0107], [0110]-[0121]).

As per claim 2, Fransdonk further discloses the method comprising receiving information regarding the expected use of the content file (see FIG. 2, and para [0061]-[0062]); and wherein the determining step further comprises determining in response to the identified content and the received information regarding the expected use (see FIG. 2, and para [0063]).

As per claim 3, Fransdonk further discloses wherein the content is computer software (see FIG. 1, 3, and para [0010], [0016], [0065], [0079]).

As per claim 4, Fransdonk further discloses wherein the content subject to export control is an encryption algorithm (see FIG. 6A, 6B, 24, and para [0218]-[0220], [0370]-[0372]).

As per claim 5, Fransdonk further discloses the method comprising identifying content subject to export control by presenting examination results to an user (see FIG. 4, 7, and para [0107], [0110]-[0121]).

As per claim 6, Fransdonk further discloses the method comprising aggregating the determined export requirements with export requirements applicable to other content files (see FIG. 7, and para [0232], [0238]).

As per claim 7, Fransdonk further discloses the method comprising aggregating the determined export requirements with export requirements obtained from a publicly available database of export information (see FIG. 4, 7, and para [0105], [0113]-[0114], [0119]-[0121]).

As per claim 8, Fransdonk discloses a system for export compliance, (see FIG. 1, and para [0010], [0016], [0022]), comprising: an examination subsystem for performing an examination of one or more content files (see FIG. 1, and para [0023]), an identification subsystem for identifying in response to examination results content used by or included in the one or more content files that is indicative of content subject to export control (see FIG. 1, 7, and para [0013], [0019], [0032], [0105], [0232]); determination subsystem for determining in response to the identified content, export requirements applicable to the one or more content files (see FIG. 1, 7, and para [0105], [0107]); and an indication subsystem, for providing an indication of the determined export requirements (see FIG. 4, 7, and para [0107], [0110]-[0121]).

As per claim 9, Fransdonk further discloses the system comprising a receiving subsystem for receiving information regarding the expected use of the content file (see FIG. 2, and para [0061]-[0062]); and wherein the determining subsystem determines export requirements in response to the identified content and received information regarding the expected use (see FIG. 2, and para [0063]).

As per claim 10, Fransdonk further discloses wherein the content is computer software (see FIG. 1, 3, and para [0010], [0016], [0065], [0079]).

As per claim 11, Fransdonk further discloses wherein the content subject to export control is an encryption algorithm (see FIG. 6A, 6B, 24, and para [0218]-[0220], [0370]-[0372]).

As per claim 12, Fransdonk further discloses wherein the identification subsystem identifies content subject to export control by presenting examination results to a user, (see FIG. 4, 7, and para [0107], [0110]-[0121]), and receiving user input regarding the content (see FIG. 18, and para [0348], [0351]).

-- Please See Continuation Sheet --

Supplemental Box

In case **the space in any of the preceding boxes is not sufficient.**
Continuation of:
Box V. 2. Citations and Explanations:

Claims 13-24 lack an inventive step under PCT Article 33(3) as being obvious over Fransdonk in view of US 2003/0018891 A1 to Hall et al. (hereinafter "Hall").

As per claim 13, Fransdonk discloses a method for export compliance, (see FIG. 1, and para [0010], [0016], [0022]), comprising: examining a software program (see FIG. 1, 3, and para [0010], [0016], [0065], [0079]); but does not specifically disclose identifying a portion of the software program indicative of encryption technology included in or used by the software program; determining export requirements associated with the encryption technology indicated by the identified portion of the software program; and providing an indication of the determined export requirements for the software program. Hall, however, discloses identifying a portion of the software program indicative of encryption technology included in or used by the software program (see FIG. 3, and para [0030], [0041]-[0044]); determining export requirements associated with the encryption technology indicated by the identified portion of the software program (see FIG. 3, and para [0031], [0041]); and providing an indication of the determined export requirements for the software program (see FIG. 3, and para [0027], [0041], [0049]). It would have been obvious to one of ordinary skill in the art to combine the teachings of Fransdonk with those of Hall because adding the tripartite identification-determination-indication adaptation to the method whereby the encrypted software is first identified in the content and subsequently associated with applicable export requirements and thereafter processed by an indication subsystem, would have equipped the method with a standardized routine of software encryption processing, thus enhancing the functionality of Fransdonk (see Hall: FIG. 3, and para [0027], [0030]-[0031]).

As per claim 14, Hall further discloses the method comprising receiving information regarding the expected use of the software program (see FIG. 2, and para [0026]); and wherein the determining step further comprises determining export requirements in response to the identified portion of the software program and the received information regarding the expected use (see FIG. 2, 3, and para [0026]-[0028], [0041]).

As per claim 15, Hall further discloses wherein the identified portion is an encryption algorithm (see FIG. 3, and para [0028]).

As per claim 16, Hall further discloses wherein the identified portion interfaces with an encryption algorithm (see FIG. 2, 3, and para [0027] -[0028]).

As per claim 17, Hall further discloses the method comprising identifying a portion of the software program by presenting examination results to a user (see FIG. 3, and para [0027]).

As per claim 18, Hall further discloses the method comprising identifying a portion of the software program without user intervention (see FIG. 3, and para [0029]).

As per claim 19, Fransdonk discloses a system for export compliance, (see FIG. 1, and para [0010], [0016], [0022]), comprising: an examination subsystem for examining a software program (see FIG. 1, 3, and para [0010], [0016], [0065], [0079]); but does not specifically disclose an identification subsystem for identifying a portion of the software program indicative of encryption technology included in or used by the software program; a determination subsystem for determining export requirements associated with the encryption technology indicated by the identified portion of the software program; and an indication subsystem for providing an indication of the determined export requirements for the software program. Hall, however, discloses an identification subsystem for identifying a portion of the software program indicative of encryption technology included in or used by the software program (see FIG. 3, and para [0030], [0041]-[0044]); a determination subsystem for determining export requirements associated with the encryption technology indicated by the identified portion of the software program (see FIG. 3, and para [0031], [0041]); and an indication subsystem for providing an indication of the determined export requirements for the software program (see FIG. 3, and para [0027], [0041], [0049]). It would have been obvious to one of ordinary skill in the art to combine the teachings of Fransdonk with those of Hall because adding the tripartite identification-determination-indication subsystem adaptation whereby the encrypted software is first identified in the content and subsequently associated with applicable export requirements and thereafter processed by an indication subsystem, would have equipped the system with a standardized subroutine of software encryption processing, thus enhancing the functionality of Fransdonk (see Hall: FIG. 3, and para [0027], [0030]-[0031]).

As per claim 20, Hall further discloses the system comprising a receiving subsystem for receiving information regarding the expected use of the software program (see FIG. 2, and para [0026]); and wherein the determination subsystem determines export requirements in response to the identified portion of the software program and the received information regarding the expected use (see FIG. 2, 3, and para [0026]-[0028], [0041]).

As per claim 21, Hall further discloses wherein the identified portion is an encryption algorithm (see FIG. 3, and para [0028]).

As per claim 22, Hall further discloses wherein the identified portion interfaces with an encryption algorithm (see FIG. 2, 3, and para [0027] -[0028]).

As per claim 23, Hall further discloses wherein the identification subsystem identifies a portion of the software program by presenting examination results to a user (see FIG. 3, and para [0027]).

As per claim 24, Hall further discloses wherein the identification subsystem identifies a portion of the software program without user intervention (see FIG. 3, and para [0029]).

Claims 1-24 have industrial applicability as defined by PCT Article 33(4) because the subject matter can be made or used in industry.